



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,762	01/16/2004	Roger Y. Tsien	REGEN1560-1	1338
28213	7590	11/15/2004	EXAMINER	
GRAY CARY WARE & FREIDENRICH LLP 4365 EXECUTIVE DRIVE SUITE 1100 SAN DIEGO, CA 92121-2133			SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,762

Applicant(s)

TSIEN ET AL.

Examiner

Taofiq A. Solola

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 4-9 and 27 is/are allowed.
- 6) ☐ Claim(s) 1-3 and 11-26 is/are rejected.
- 7) ☐ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1626

Claims 1-~~20~~ are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13, 16, 18-23, 25-26, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to provide written description for the instant claimed compound (claim 16) wherein the histidine peptide sequence is of any length, the kit (claim 16) and complex thereof (claim 20). Applicant must show possession of the invention by describing it with all the claimed limitations. *Lookwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed Cir. 1997). By limiting the peptide length to six in claims 13, 16, 20, or delete the claims the rejection would be overcome.

Claims 13, 16, 18-23, 25-26, are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for six histidine residues does not reasonably provide enablement for any length of histidine residue(s). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with claims 13, 16 and 20. The claimed process is not believable on its face.

For rejection under 35 U.S.C. 112, first paragraph, the following factors must be considered (In re Wands, 8 USPQ2d 1400, 1404 (CAFC, 1988):

- 1) Breadth of claims.
- 2) Nature of invention.
- 3) State of prior art.
- 4) Level of ordinary skill in the art.
- 5) Level predictability in the art.
- 6) Amount of direction and guidance provided by the inventor.
- 7) Existence of working examples.
- 8) Quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The breadth of the claimed invention involves utility of a compound. The nature of the invention is in the field of using a compound as a label of histidine-rich peptide sequence. The state of the prior art is what prior art knows about the nature of the invention. There is no known prior art claiming using the compound as a label for sequence having any length of histidine peptide. The level of ordinary skill in the art is high but only in labeling sequence having only six histidine peptides as disclosed in the specification. The predictability or lack thereof in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. The lower the predictability, the higher the direction and guidance that must be provided by applicant. In the instant invention the predictability is very low and consequently, the need for higher levels of direction and guidance by applicant. However, the amount of

Art Unit: 1626

direction and guidance provided by applicant is limited to labeling sequence having six histidine peptides. There is no evidence in the specification that established correlation between applicant experiment and a labeling a sequence having any length of histidine peptide(s). See Ex parte Mass, 9 USPQ2d 1746, 1987. Therefore, the quantity of experimentation required to use the invention as claimed, based on applicant's limited disclosure would be undue burden because, one of ordinary skill in the art would have to perform significant amount of experiments. By deleting the claims or limit the sequence to six peptides in the claims the rejection would be overcome.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-3, 11-26, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13, 16, 18-23, 25-26, are rejected as indefinite because it is not possible to ascertain the meets and bounds of the claims for reasons set forth above. By deleting the claims or limit the sequence to six peptides in the claims the rejection would be overcome.

The term "about" in claim 1 and in every occurrence renders claims 1-3, 11-26 indefinite. About 11 means 10.5 or 11.5. For example in claim 1, it is not possible for "m" to be "about 11." It must be a whole number. This is also true for claims 2, 14, 17,

Art Unit: 1626

21-22 and 24. By deleting the term in every occurrence the rejection would be overcome.

In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

Claims 11-15 are improperly depend from claim 1. Claims 17-19 are improperly depend from claim 16. Claim 21 is improperly depend from claim 20. Claims 23-26 are improperly depend from claim 22. The dependent claims recite certain characters of the invention. According to the specification the independent claims have the recited characters. The dependent claims fail to further limit the scope of their respective independent claims as required under US patent practice. Therefore, claims 11-15 are substantial duplicate of 1, 17-19 are duplicate of 16, 21 is a duplicate of 20 and 23-26 are substantial duplicate of 22. By deleting the dependent claims the rejection would be overcome.

Claim 3 is indefinite because the claim depends from itself.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Art Unit: 1626

Claims 1-26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-26 of copending Application No. 10/346,658. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Allowable Subject Matter

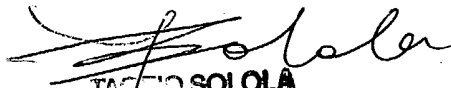
Claim 27 is in condition for allowance over prior arts of record.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, J.D. whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.


TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1626

TAOFIQ SOLOLA
PRIMARY EXAMINER

November 10, 2004